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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,698	09/25/2003	Eduard K. de Jong	SUN-P7008	9219
24209 7590 08/15/2007 GUNNISON MCKAY & HODGSON, LLP 1900 GARDEN ROAD SUITE 220 MONTEREY, CA 93940			EXAMINER HOANG, DANIEL L	
			ART UNIT 2136	PAPER NUMBER
			MAIL DATE 08/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/672,698	Applicant(s) DE JONG, EDUARD K.	
	Examiner Daniel L. Hoang	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7, 17, 18, 28, 29, 39, 40, 45-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-16, 19-27, 30-38, 41-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments and amendments, see applicant's arguments/remarks page 16 of 20, filed 4/27/07, with respect to the rejection(s) of claim(s) 1, 6, 12, 17, 23, 28, 34, 39, 45, 47, and 48 under 35 USC 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Saez, US Patent No. 6,966,002.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 2, 5, 11, 13, 16, 22, 24, 27, 33, 35, 38, and 44, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Said claims recite the limitation, "said user device comprises a smart card including a virtual machine". There does not exist in applicant's specification any indication of a smart card including a virtual machine. Rather, the specification discloses a user device that includes a virtual machine and a smart card. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 2, 5, 11, 13, 16, 22, 24, 27, 33, 35, 38, and 44 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims recite the limitation, "said user device comprises a

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smart card including a virtual machine". It is unclear whether applicant intends the claim to mean that the user device comprises both a smart-card and a virtual machine or if the claim means the smart-card has the virtual machine inside itself. For purposes of examination, examiner interprets the claim to read that the user device comprises a smart-card and the smart card contains a virtual machine inside itself.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-4, 8-9, 12, 14-15, 19-20, 23, 25-26, 30-31, 34, 36-37, 41-42, 47-48, are rejected under 35 U.S.C. 103(a) as being unpatentable over Torrubia-Saez, US Patent No. 6,966,002, hereinafter Saez.

As per claim 1, 12, 23, 34, 39, 45, 47, Saez teaches:

A method for enrolling for receipt of one or more obfuscated application programs, the method comprising:

issuing an enrollment request comprising a target ID [*"system identification information"*], said enrollment request for receipt of one or more obfuscated application programs [*"software product"*] controlled by an application program provider [*"server"*], said target ID specifying a user device [*"components of the user's computer"*] configured to execute said one or more obfuscated application programs;

[see col. 18, lines 6-9] "the server sends a software product, which is either an executable object or a data object, to the user's computer, in response to a request sent to the server from the user's computer."

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[see col. 18] "In response to input from the user, an access control executable portion of the software product (if an executable object) or of the driver executable (if the software product is a data object) causes the user's computer to transmit a purchase request for partial or full access to the software product, and the server receives the purchase request. Step 1240 follows, at which the server sends to the user's computer a program which generates system identification information based on data that is specific to the user's computer. For example, the data used to generate the system identification information may include serial numbers of such components of the user's computer as the hard disk, the network interface card, the motherboard, and so forth. The user's computer then sends to the server the resulting system identification information, as well as information, such as a credit card number, which is required to complete the transaction. This information is received at the server, as indicated at step 1250. Following step 1250 is step 1260, at which the server validates the credit card information and generates a decryption key and/or a decryption executable program on the basis of the system identification information received from, and specific to, the user's computer."

obtaining a secret in response to said issuing; and

[see col. 18, lines 49-51] "The decryption key and/or decryption executable program are then transmitted to the user's computer from the server, as indicated at step 1270."

associating said secret with said application program provider, said secret for use in executing said one or more obfuscated application programs received from said application program provider.

[see col. 18, lines 52-55] "The decryption key and/or decryption executable program are then used in the user's computer to decrypt the software object to which the user has just purchased usage rights."

Saez does not explicitly teach:

The reception of said one or more obfuscated executable application programs occurs after obtaining a secret, which occurs in response to an enrollment request. In contrast, Saez teaches that the obfuscated executable application programs are received after the enrollment request is issued but before a secret is obtained. After further consideration, examiner determines that it would have been obvious at the time of the invention to one of ordinary skill in the art to which the subject matter pertains to modify the Saez invention in order to allow the system taught by Saez to receive the program after the secret is obtained. Sending the program after the secret is obtained would allow the server to encrypt the program based on the requestor's secret. The requestor can then receive the encrypted program and decrypt it accordingly using its secret. Examiner deems these processes of encryption/decryption are well known in the art.

As per claim 3, 14, 25, 36, Saez teaches:

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A method for enrolling for receipt of one or more obfuscated application programs, the method comprising:
receiving an enrollment request comprising a target ID, said enrollment request for access by a user device to one or more obfuscated application programs, said target ID specifying said user device, said user device configured to execute said one or more obfuscated application programs;

[see rejection of claim 1]

determining a secret in response to said request; associating said secret with said target ID; and

[see rejection of claim 1, "the server validates the credit card information and generates a decryption key and/or a decryption executable program on the basis of the system identification information received from, and specific to, the user's computer."]

transferring said secret to said user device.

[see col. 18, lines 49-51] "The decryption key and/or decryption executable program are then transmitted to the user's computer from the server, as indicated at step 1270."

As per claim 4, 15, 26, 37, Saez teaches:

The method of claim 3 wherein said determining and said transferring form part of a key exchange protocol.

[see rejection of claim 3, wherein the generating and transmitting of the decryption key are considered as forming part of a key exchange protocol.]

As per claim 8, 19, 30, 41, Saez teaches:

A method for application program obfuscation, the method comprising:

determining a current obfuscation method based at least in part on a target ID, said target ID specifying a user device configured to execute said obfuscated application program;

[see rejection of claim 1] "the server validates the credit card information and generates a decryption key and/or a decryption executable program on the basis of the system identification information received from, and specific to, the user's computer."

The decryption key that will be generated is based in part on the payment authorized by user's credit card as well as system identification information. Depending on the amount of payment, user will be

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authorized to use certain portions/versions of the software product. The appropriate decryption key will be generated allowing user access to said portions.

creating an obfuscated application program based at least in part on said current obfuscation method;
and

[see col. 3] "a software package is provided, comprising: a software object having a first set of features and a second set of features, the first set of features being encrypted and the second set of features being unencrypted; and a signature readable by a predetermined executable serving to control access to the encrypted first set of features."

sending said obfuscated application program to said user device.

[see rejection of claim 1]

As per claim 9, 20, 31, 42, Saez teaches:

The method of claim 8, further comprising receiving an application program request from said user device, said determining occurring in response to said receiving.

[see rejection of claim 1, wherein the decryption key is generated after the user requests the software product.]

Claims 10, 11, 21, 22, 32, 33, 43, 44, are rejected under 35 U.S.C. 103(a) as being unpatentable over Saez as applied to claims 8-9 above, and further in view of Rusnak et al., US Patent No. 6,098,056.

As per claim 10, 21, 32, 43:

The method of claim 8 wherein said method further comprises, after said creating, applying a cryptographic process to said obfuscated application program together with a cryptographic key to create an encrypted obfuscated application program; and said sending comprises sending said encrypted obfuscated application program.

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The Saez reference has been discussed above. Saez does not teach applying a cryptographic process to the obfuscated application program to create an encrypted obfuscated application program.

Rusnak teaches doubly encrypting a document encryption key (DEK) as seen below:

[see col. 3] "After authentication, the server decrypts the DEK with its private key; encrypts the newly encrypted DEK with TIH's public key; encrypts the decrypted key with the client's public key; and returns the doubly encrypted DEK to the client."

It would have been obvious at the time of the invention to one of ordinary skill in the art to modify the Saez invention to doubly encrypt the content being transmitted in order to authorize and authenticate both user and server, thus improving the overall security of the system.

As per claim 11, 22, 33, 44:

[see rejection of claim 2]

Allowable Subject Matter

Claims 2, 5, 11, 13, 16, 22, 24, 27, 33, 35, 38, and 44, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action

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is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

- *. Any response to this Office Action should be **faxed to (571) 273-8300 or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulaney Street
Alexandria, VA 22314

- *. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Hoang whose telephone number is 571-270-1019. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m., EST.

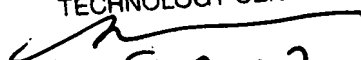
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel L. Hoang
8/02/07

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8/3/07